

**PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Beltran
Serial No: 10/657,745
Filing Date: 9/8/03
Title: APPARATUS FOR TRANSPORTING A CONTAINER

Examiner: Wood, Kimberly
Art Group: 3632
Docket No: BELTRAN 01

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Date: 3/26/07

Pre-Appeal Brief Request for Review

1. In the Final Office Action dated 10/24/06, the Examiner reasserted the rejection of claims 1-9, 16-21, and 28-31. In particular, claims 1-9, 16-21, and 28-31 have been rejected under 35 USC § 102 (b) as being anticipated by Burrell (U.S. Patent No. 3,753,543). In addition, the Examiner indicated that this application contains claims directed to the following patentable distinct species of the claimed invention: Species I drawn to figures 1-3; Species II drawn to figures 4, 5A, 5B, 6A, and 6B; Species III drawn to figure 5; Species IV drawn to figure 7A and 7B; and Species V drawn to figure 8. Applicant respectfully believes that there is a clear deficiency in the prima facie case in support of these rejections and requests review of the allowability of claims 1-37.
2. Claims 1-9, 16-21, and 28-31 have been rejected under 35 USC § 102 (b) as being anticipated by Burrell (U.S. Patent No. 3,753,543). The applicant respectfully disagrees with this rejection and the reasoning thereof.

Burrell does not teach or suggest a base having a first geometric shape in a first plane to support the container. Instead, Burrell teaches at column 2, lines 14 – 21 a yoke comprising a base 24 and a pair of generally parallel spaced apart projecting arms 25 is welded or otherwise fixed to one end of support plane 10. Arms 25 in turn are welded or otherwise rigidly secured to a generally circular support ring 26, which is open on one side and is provided with a pair of outwardly projecting ears 27 and 28. Support ring 26 is of a size to receive and engage the bottom flange 19 of the gas container.

As such, Burrell is teaching that the support ring 26 engages the container, not the base as is presently claimed. Thus, claims 1-9, 16-21, and 28-31 are not anticipated by Burrell.

3. The application contains claims directed to the following patentable distinct species of the claimed invention: Species I drawn to figures 1-3; Species II drawn to figures 4, 5A, 5B, 6A, and 6B; Species III drawn to figure 5; Species IV drawn to figure 7A and 7B; and Species V drawn to figure 8.

37 CFR § 1.142 (Requirement for restriction)

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

(b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

MPEP 802.01 Meaning of "Independent" and "Distinct" (in part)

35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

MPEP 803 Restriction - When Proper (in part)

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

MPEP 806 Determination of Distinctness or Independence of Claimed Inventions

The general principles relating to distinctness or independence may be summarized as follows:

(A) Where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, MPEP § 806.04 - § 806.04(i), though a reasonable number of species may be claimed when there is an allowed (novel and unobvious) claim generic thereto. 37 CFR 1.141, MPEP § 809.02 - § 809.02(e).

(B) Where inventions are related as disclosed but are distinct as claimed, restriction may be proper.

(C) Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper.

Where restriction is required by the Office double patenting cannot be held, and thus, it is imperative the requirement should never be made where related inventions as claimed are not distinct. For (B) and (C) see MPEP § 806.05 - § 806.05(i) and § 809.03. See MPEP § 802.01 for criteria for patentably distinct inventions.

The present patent application includes 6 independent claims and a total of 37 claims. Claim 1 has dependent claims 2-8, claim 10 has dependent claims 11-15, claim

16 has dependent claims 17-21, claim 22 has dependent claims 23-27, claim 28 has dependent claims 29-31, and claim 32 has dependent claims 33-37.

Independent claims 1, 16, and 28 are directed towards apparatus for transporting a container, a plurality of containers, and for carrying a vase of flowers, respectively. Each of independent claims 1, 16, and 28 include a base, a retaining section, and a brace. While these claims may be distinct (i.e., patentable over one another), they are not directed towards independent inventions since there is only one subject disclosed; that being an apparatus for transporting one or more containers, which includes a vase of flowers. As defined in MPEP 802.01, "independent inventions" means that there is **no disclosed relationship between the two or more subjects disclosed**.

Independent claims 10, 22, and 32 are directed towards a system for transporting a plurality of containers, or vases of flowers. Each of these independent claims includes a plurality of transporting apparatuses and a support structure, where the transporting apparatuses relates to one or more of independent claims 1, 16, and 28. While independent claims 10, 22, and 32 may be distinct (i.e., patentable over one another), they are not independent of each other or of claims 1, 16, and 28. In particular, only one subject is disclosed for the present invention, that being transporting containers, which may be done in a system. As stated in MPEP 802.01 The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

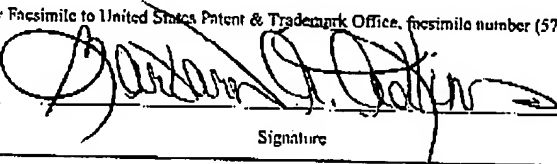
Based on the foregoing reasons, the applicant requests that the Examiner withdraw the restriction requirement.

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RESPECTFULLY SUBMITTED,

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/99) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,534</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u> </u>		<u>/Timothy W Markison/ reg no 33,534</u> Signature <u>Timothy W Markison</u> Typed or printed name <u>808 665-1725</u> Telephone number <u>3/26/07</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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